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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,607	04/21/2004	Carl M. Mendel	BBC-128/1	5201
34213 7590 01/22/2007 ABBOTT BIORESEARCH 100 RESEARCH DRIVE WORCESTER, MA 01605-4314			EXAMINER ROYDS, LESLIE A	
			ART UNIT	PAPER NUMBER
			1614	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

NOTICE OF NON-RESPONSIVE AMENDMENT

Election by Original Presentation

This notice of non-responsive amendment is in reply to Applicant's amendment filed October 30, 2006, which has been received and entered into the application.

The MPEP states at §819:

“The general policy of the Office is not to permit the Applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter.”

Presently presented claims 1 and 3-11 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are now drawn to a method for treating fibromyalgia, where the claims as originally filed were drawn to a method for treating neuropathic pain.

The inventions are directed to related processes. The related inventions are distinct if (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. Please reference MPEP §806.05(j). In the instant case, the inventions as claimed are directed to methods with different objectives, steps and patient populations in which the method is to be practiced.

In particular, the originally claimed methods and the newly claimed methods are related because they recite the administration of a compound of Formula (I), or an enantiomer or pharmaceutically acceptable salt thereof. However, the originally claimed method on which examination was performed was directed to a method for treating neuropathic pain in a human in need thereof, wherein the newly claimed method is directed to a method for treating fibromyalgia in a human in need thereof. Accordingly, the originally claimed method and the present method clearly have different modes of operation, function and/or effects.

Furthermore, the originally claimed methods and the present methods comprise steps that are not required for the practice of the other. In particular, the originally claimed methods required the administration of the compound of Formula (I) (or an enantiomer or pharmaceutically acceptable salt thereof) to a human suffering from neuropathic pain, whereas the present method requires the administration of the compound of Formula (I) (or an enantiomer or pharmaceutically acceptable salt thereof) to a human suffering from fibromyalgia.

Additionally it is noted that the dosage amounts or frequency and route of administration necessary to effect the treatment of neuropathic pain with the claimed compound of Formula (I) would necessarily be independent and distinct from that required for the treatment of fibromyalgia using the same, due to the differences in etiology of such conditions and the activity of the claimed agent in treating such conditions.

Accordingly, the modes of operation, functions and/or effects of the methods are clearly distinct from one another, despite the fact that the functional agent used to accomplish both the originally claimed methods and the present methods remains the same, i.e., the administration of a compound of Formula (I). In view of the fact that the inventions as claimed clearly do not encompass overlapping subject matter (i.e., the treatment of neuropathic pain is clearly independent and distinct from the treatment of fibromyalgia) and there is nothing of record to show them to be obvious variants, the inventions are properly held to be patentably distinct from one another.

Since Applicant has received an action on the merits for the originally presented invention (i.e., methods of treating neuropathic pain), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, all claims are withdrawn from consideration as being directed to a non-elected invention. Please reference 37 C.F.R. 1.142(b) and MPEP §821.03).

The amendment filed on October 30, 2006 presenting only claims drawn to a non-elected invention is non-responsive (MPEP §821.03). The claims are not readable on the elected invention

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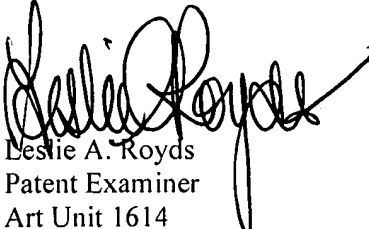
because they are now drawn to a method of treating fibromyalgia, while the elected invention (i.e., the invention of the originally presented claims) was directed to a method of treating neuropathic pain.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, Applicant is given a **TIME PERIOD** of **ONE (1) MONTH** or **THIRTY (30) DAYS**, whichever is longer, from the mailing date of this notice within which to supply the omission or correction, as well as a proper response to the previous Office Action, in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD UNDER 37 C.F.R. 1.136(a) ARE AVAILABLE.**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Leslie A. Royds
Patent Examiner
Art Unit 1614

January 8, 2007

 1/10/07
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER